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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/812,945
	Filing Date	March 27, 2001
	First Named Inventor	Hsuan-Yin Lan-Hargest et al.
	Art Unit	1617
	Examiner Name	Shengjun Wang
Total Number of Pages in This Submission	Attorney Docket Number	15128.0002

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD Remarks	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Response to Second Restriction Requirement (2 pages); and Return Receipt Postcard
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Steptoe & Johnson LLP	
Signature		
Printed name	Harold H. Fox	
Date	April 11, 2005	Reg. No. 41,498

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of: Hsuan-Yin Lan-Hargest et al.

Examiner: Wang, Shengjun

Serial No. 09/812,945

Group Art Unit: 1617

Filed : March 27, 2001

Docket No.: 15128.0002

For: *Histone Deacetylase Inhibitors*

Mail Stop Amendment

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RESPONSE TO SECOND RESTRICTION REQUIREMENT

Applicants have discovered a method of inhibiting histone deacetylase activity in cells which includes contacting the cells with an effective amount of a compound of formula (I), thereby treating one or more disorders mediated by histone deacetylase. See claim 1.

In response to the outstanding Restriction Requirement dated March 11, 2005, Applicants elect, with traverse, Group IV, claims 1, 2, 4-7, 10, 12, 17, 18, 40-42, 44-46 with the understanding that the Examiner has designated Group IV as a method of inhibiting histone deacetylase activity in cells. This method includes contacting the cells with an effective amount of a compound of formula (I) thereby treating one or more disorders mediated by histone deacetylase and wherein said disorder is cancer.

Applicants understand that each group was further restricted based on group A and elect with traverse, compounds in which A is a phenyl group. Applicants further confirm the previous election of 7-phenyl-2,4,6-hepta-trienoylhydroxamic acid for examination.

Applicants make this election with traverse. It is not apparent to the Applicants what the Examiner's reasons were for the present restriction. In Applicants' response to the Examiner's previous restriction requirement dated February 6, 2002, Applicants elected 7-phenyl-2,4,6-hepta-trienoylhydroxamic acid as the elected compound and cancer as the elected disorder. These elections were affirmed by the Board of Patent Appeals and Interferences in their decision

mailed December 24, 2003. Groups I, II, III, V, and VI-XI as proposed by the Examiner, do not fall within the scope of the previously elected compound or disorder.

Further, the Examiner has now restricted the elected invention to Groups I-XI "[i]n view [sic] the complexity of the remain [sic] subject matters within the elected invention." Office Action at page 2. However, MPEP 803 states that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). Under the guidelines set forth in the MPEP, "a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search." Given the fact that the previously elected claims have been extensively examined since 2001 and the fact that the currently restricted groups do not read on the previously elected compound and disorder, Applicants assert that the Examiner has not met this *prima facie* showing in this current Office Action.

In conclusion, Applicants believe that the Applicants' response to the last Office Action dated November 2, 2004, addresses and overcomes all claim rejections set forth by the Examiner. As such, the claims and all dependent claims, meet all criteria for patentability and are in condition for allowance.

Should any fees be required by the present Amendment, the Commissioner is hereby authorized to charge Deposit Account **19-4293**. If, for any reason, a telephonic conference with the Applicants would be helpful in expediting prosecution of the instant application, the Examiner is invited to call Applicants' Attorney at the telephone number provided below.

Respectfully submitted,



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